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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,319	01/15/2004	John K. Junkers	2852	5368
7590 01/18/2006			EXAMINER	
Striker, Striker & Stenby 103 East Neck Road Huntington, NY 11743			SHAKERI, HADI	
			ART UNIT	PAPER NUMBER
			3723	

DATE MAILED: 01/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	10/758,319	JUNKERS, JOHN K.	
	Examiner	Art Unit	
	Hadi Shakeri	3723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 3,5,7,12,13,15-17,20-22,24-27 and 30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,6,8-11,14,18,19,23,28,29 and 31-33 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>030404; 082305</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. Claims 3, 5, 7 (Fig. 6, page 24), 12 (Fig. 6), 13 (Fig. 5), 15, 16, 20-22, 24-27 and 30 (Fig. 6; page 23 line 18) are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Species, there being no allowable generic or linking claim.

Applicant timely traversed the restriction (election) requirement in the reply filed on 11/21/05.

The traversal is on the ground(s) that claim 1 is common to all different species and forcing the applicant to choose one species is not beneficial either to the applicant or to the public and may necessitate the possibility of filing divisional applications with increasing expense to the applicant. This is not found persuasive because the office action had indicated that if Applicant believes that these species are not patentably distinct, all claims would have been examined, but prior art readable over one species would have been applied to all other species per Applicant's admission that the different species are not patentably distinct. If applicant believes that these species are patentably distinct, as it appears to be the case here, different applications for the different inventions are required per office practice and in the interest of the public, since proper time and resources would be applied to the examination of the different inventions. It is also noted that upon allowance of a generic claim, all possible species readable on the allowed generic claim would be rejoined.

The requirement is still deemed proper and is therefore made FINAL.

Specification

2. The disclosure is objected to because of the following informalities: The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors, e.g., reference character (14'), page 23, line 15, should be changed to

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(141). Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

3. Claims 8, 11 and 31 are objected to because of the following informalities: in claim 8, line 1, "claim 1;" should be changed to, --claim 1,--; in claim 11, "a nut", should be changed to, --the nut--, as recited in the parent; and in claim 31, "apppllicable", should be changed to, --applicable--.

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: WASHER.

5. The amendment filed 05/06/04 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the provision that the inner segment is replaceable with another inner segment as recited in then newly added claim 2.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claim 2 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 2, introduced not at the time of filling but with the amendment filed over three months later

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than the filing date, introduces new matter. Applicant is requested to point out the support for the subject matter in the originally filed specification or to cancel the claim.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1, 2, 4, 6, 8-11, 14, 17-19, 23, 28, 29 and 31-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Regarding claim 1, the language, i.e., "said body being arranged to enhance a cooperation between said at least one inner segment and said another end of the rod underneath said at least threaded portion" renders the claim indefinite. One end and another end of the rod, as best understood, is defined by reference characters (10) and (11) respectively. The body (2) is arranged to engage the other end (11), which includes the threaded portion (12), the "one end" (10) is underneath the objects (7, 8), which does not engage the washer, rendering the language as recited indefinite.

11. It is further noted with respect to claim 1, that "said body having an axis..., and with the at least one inner surface adapted to cooperate with said at least one inner segment" as recited in lines 12-14, also renders the claim indefinite for making the scope unascertainable. The washer is defined to have an inner surface (5), but the inner surface (15) of the moveable member (14) is described (page 18, 2nd paragraph) to cooperate with the inner segment (6), thus it is not clear whether the applicant is claiming surface (5) (which does not "cooperate", as defined by specification, with the inner segment 6) or inner surface (15) of the immovable member 14 not yet recited until claim 8.

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12. It is further noted that narrative, functional, and the intended use language does not appear to provide patentable weight to the claim but only renders the claim ambiguous.

13. With regards to claim 6, the language as recited renders the claim indefinite, for making it appear a method of forming and/or a method of assembly is being recited in an article claim. What is the element or feature to further limit the parent claim? The recitation, e.g., "formed so", "installed on the rod to permit putting the washer on the rod by hand" fail to particularly further limit the washer. This applies to all the claims wherein such language is used.

14. With regards to claim 8, in view of new rules for invoking 112, 6th paragraph, means for "creating friction" appears inappropriate.

15. Claim 23, recites for the inner surface to be formed as a wedging surface, thus referring to surface (15) of the movable member (14) which is not recited in the parent claim, and as such lacks sufficient antecedent basis.

16. It is unclear what is being claimed by claims 32 and 33. To frictionally enhance the second outer surface (4) is defined by "providing the objects 7, 8 to be stationary", page 21, lines 9-10. There is no other suggestion or disclosure to frictionally enhance the surface. Keeping the workpiece stationary does not further limit the washer being claimed in the article claims as recited. With regards to claim 33, same page lines 11-12, define reducing the friction on the first outer surface (3) by applying lubricant, which also fails to further limit the washer.

Claim Rejections - 35 USC § 102

17. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

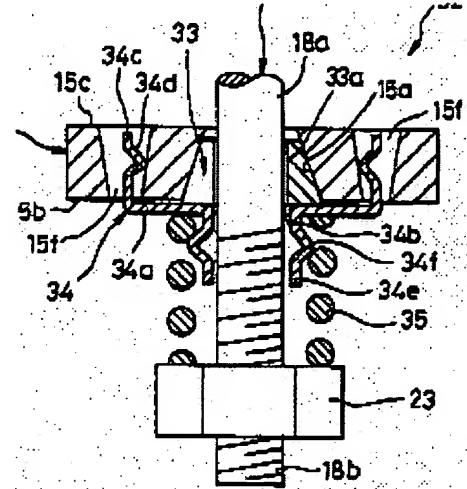
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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18. Claims 1, 2, 4, 6, 8-11, 14, 17-19, 23, 28, 29, and 31-33 (as best understood) are rejected under 35 U.S.C. 102(b) as being anticipated by Kato (6,244,806).

Kato discloses all of the limitations of the above claims as best understood, i.e., a washer (e.g., 32) having a body with first and second outer surface capable of contacting a nut and a workpiece; at least one inner segment (33) cooperating with a fastener; the body having at least one inner surface (15a) cooperating with the inner segment (33) to increase/decrease the friction; means (34, 35) for effecting the change in friction comprised of a movable member (34) extending outwardly beyond a counter (as defined by Fig. 1b, and not Figs. 5, or 6) with at least one portion of the movable member (section in contact with 33) arranged to bring the inner segment (33) in closer contact with the fastener or to decrease the friction, and a spring (35).



Double Patenting

19. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

20. Claims 1, 6, 8-11, 14, 17-19, 23, 28, 29 and 31 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1,4, 6-9,12, 15-17, 21, 26, 27 and 29 of copending Application No. 11/082,012. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

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21. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

22. Claims 2, 4, 32 and 33 (as best understood) are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 11/082,012 in view of prior art cited above and one of ordinary skill in the art. The subject matter of the above claims are considered obvious modification to one of ordinary skill in the art in view of prior art cited above and/or to be within the knowledge of one of ordinary skill in the art.

This is a provisional obviousness-type double patenting rejection.

Conclusion

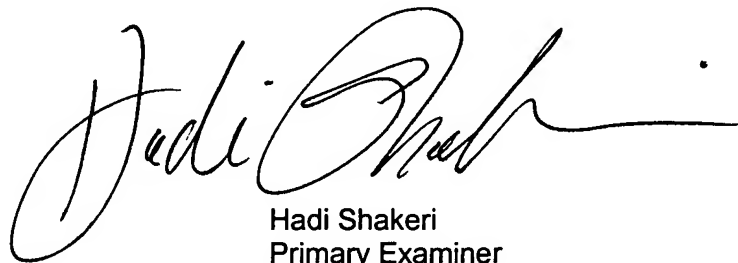
23. Prior art made of record and not relied upon are considered pertinent to applicant's disclosure. Bradley, Jr., Jones and Geise are cited to show related inventions.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hadi Shakeri whose telephone number is (571) 272-4495. The examiner can normally be reached on Monday-Friday.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Hadi Shakeri', with a long horizontal flourish extending to the right.

Hadi Shakeri
Primary Examiner
Art Unit 3723
January 13, 2006